Remarks

The Office Action dated August 28, 2003 has been received and considered by the Applicant. Claims 1-21 are currently pending in the present application for invention. Claims 1-21 are rejected by the Office Action dated August 28, 2003. The foregoing amendment adds new claims 22-34 which are similar in scope to claims 1-13 of the originally filed specification, and new claims 35-42 which re based on the first two pages of the detailed description.

The Office Action dated August 28, 2003 rejects claims 1-4 and 11-21 under the provisions of 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out the invention. Each of the items mentioned by the Examiner in making this rejection have been corrected by the foregoing amendment to the claims.

The Office Action dated August 28, 2003 rejects claims 9, 10 and 16 under the provisions of 35 U.S.C. §101 as being directed to non–statutory subject matter. The Examiner states that data on a disk is not statutory unless that data is a data structure. The Applicant, respectfully, disagrees with this assertion contained in the Office Action. The Applicant, respectfully, asserts that claims 9, 10 and 16 recite statutory subject matter. Claims 9, 10 and 16 each recite a medium mark, wherein a content of said medium mark comprises a first bitpattern, and recorded user information encoded with a watermark representing a second bitpattern having a predefined relationship with the first bitpattern whereby the relationship between the second bitpattern and the content of the first bitpattern can be verified in a computer process. The Applicant, respectfully, submits that the foregoing passage clearly recites statutory subject matter.

The Examiner has drawn the Applicant's attention to the MPEP at §2106 IV B.1. (b). The Applicant would like to, respectfully, point out that this section of the MPEP contains the statement that "data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer." In order for this rejection under the provisions of 35 U.S.C. §101 to stand, the recited data must merely be stored, read or outputted by the computer. This is clearly not the case with rejected claims 9, 10 and 16 that recite multiple bit patterns stored on an information carrier, which multiple bitpatterns have a relationship that can be verified by a computer process. A

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computer process is recited by the rejected claim as a requirement to identify the functional interrelationship. The rejected claims recite elements that force the computer to process in different ways under differing circumstances. The recited first and second bitpatterns act as stored data having a predefined relationship that require a computer process to alter its' processing in accordance with the predefined relationship of the first and second bitpatterns. The first and second bitpatterns are part of the computing process, with the computing process being forced to verify the existence of the predefined relationship or not verify the existence of the predefined relationship. The Applicant, respectfully, submits, that the rejected claims recite statutory subject matter. Accordingly, this rejection is, respectfully, traversed.

The Office Action dated August 28, 2003 reiterates the rejection to claims 1-21 under the provisions of 35 U.S.C. §103(a) as being obvious over U. S. Patent No. 5,761,301 issued in the name of Oshima et al. (Oshima et al.) in view of U. S. Patent No. 6,205,249 issued in the name of Moskowitz (Moskowitz) and U. S. Patent No. 5,946,286 issued in the name of Bahns (Bahns). Specifically, the Examiner states that Oshima et al. teaches most the elements of the rejected claims, and that Moskowitz teaches embedding digital signatures into content as watermarks and that Bahns teaches watermarking an optical disc. The Applicant would like to, respectfully, point out that the reject claims to the present invention recite elements defining first and second bitpatterns having a predefined relationship. The Examiner has cited a portion of Moskowitz the discusses keys being used to encode digital watermarks. However, the cited portion of Moskowitz does not disclose, or suggest, the specific mechanics recited by the rejected claims of the present invention whereby a first bitpattern is employed for a medium mark and a second bitpattern is employed for a watermark, with the first and second bitpatterns having a predefined relationship. The Office Action Examiner cites the portion Bahns which discloses an image 22 formed on a disc 20 as a picture formed within the structure of the disc against the elements of the present invention that recite defining first and second bitpatterns having a predefined relationship used to encode digital watermarks. The Applicant does not concur that a picture formed on a disc can be read against the elements of the present invention that specifically recite first and second bitpatterns having a predefined relationship.

The MPEP at §2142 states that in order to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has provided no suggestion or motivation to modify or combine the references as was done by the Office Acton. Bahns only discloses physically forming an image on a disc, the Examiner has failed to indicate how an image formed on a disc would motivate a person skilled in the art to create the invention as recited by the rejected claims. The Examiner cites Moskowitz that discusses keys being used to encode digital watermarks in combination with Oshima et al. that discloses a mark forming apparatus. However, the cited references do not disclose, or suggest, the specific mechanics recited by the rejected claims of the present invention whereby a first bitpattern is employed for a medium mark and a second bitpattern is employed for a watermark, with the first and second bitpatterns having a predefined relationship. Furthermore, the Examiner has not stated why a combination of the various portions of the cited three references would have a reasonable expectation of success. Moreover, the combination made by the Examiner does not include all the recited elements of the rejected claims in making the rejection, specifically, the recited elements whereby a first bitpattern is employed for a medium mark and a second bitpattern is employed for a watermark, with the first and second bitpatterns having a predefined relationship, has been completely omitted by the Office Action. Accordingly, this rejection is must fail and is, respectfully, traversed.
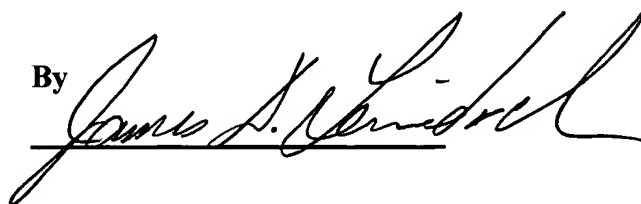
The foregoing amendment adds new claims 22-34 which are similar in scope to claims 1-13 of the originally filed specification. The Applicant, respectfully, submits that those persons skilled in the art would understand that "a medium mark representing a first bitpattern" means that the contents of the medium mark represent the bitpattern and not that the position of the medium mark represents the bitpattern. New claims 35-42 are based on the first two pages of the detailed description. These new claims recite a first bitpattern employed for a medium mark and a second bitpattern employed for a watermark, with the first and second bitpatterns having a predefined relationship. The Applicant, respectfully, submits that the cited references to not disclose, or suggest, a first bitpattern employed for a medium mark and a second bitpattern employed for a watermark, with the first and second bitpatterns

having a predefined relationship. Accordingly, these new claims are believed to be allowable over the cited references.

In view of the foregoing amendment and remarks, the Applicants believe that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By

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